

REMARKS

The Office Action mailed on March 31, 2008 (the "Office Action") has been carefully reviewed. The Applicants gratefully acknowledge the Examiner's rescission of the Sharp KK, Japanese Published Patent Application JP 2003-309755A, as cited art. It is respectfully submitted that the present invention is patentably distinguishable over the currently cited references. Reconsideration of this application, in view of the remarks, is respectfully requested.

Summary of the Rejection of the Claims

In the Office Action, the Examiner rejected claims 1-7, 18-22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Buchanan et al., U.S. Publication No. 2005/0021466 (hereinafter "Buchanan") in view of Kern, U.S. Patent No. 5,221,830 (hereinafter "Kern").

Claims 11-17 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Buchanan in view of Green et al., U.S. Patent No. 5,602,936 (hereinafter "Green") and Kern.

Claims 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Buchanan and Kern as applied to claim 7 above, and in further view of Green.

The Applicants respectfully traverse these rejections, and in view of the following arguments, request reconsideration and withdrawal thereof.

Rejection of the Claims Under 35 U.S.C. § 103(a)

Buchanan In View of Kern

Applicants respectfully traverse the Examiner's rejection of claims 1-7, 18-22 and 24 as being unpatentable over Buchanan in view of Kern. As shown below, neither Buchanan nor Kern disclose a "real time" or "concurrent" communication through the image exchange network.

The Examiner stated that "Buchanan does not explicitly disclose "real time" as defined by the applicant in communication 9/20/2007." Applicants defined "real time" in the 9/20/07 communication as:

The term "real time," as used in this inventive method, means the concurrent or simultaneous exchange of electronic or digital information between two or more computers/servers. Further, as used herein, "real time" exchange of electronic or digital information takes place without a requirement for the sequential back and forth passing of information between a first financial institution and a second financial institution.

The Examiner indicated in the rejection of independent claims 1, 2, 3, 7, 18, 22 and 24 that Kern, combined with Buchanan, does disclose a "real time" or "concurrent" transmission, communication or exchange of a digital image and/or a digital data record with a second site as recited in independent claims 1, 2, 3, 7, 18, 22 and 24. (Office Action, para. 3, re: claims 1, 2, 3, 7, 18, 22 and 24). Applicants respectfully disagree and traverse the Examiner's rejection.

Applicants respectfully assert that the Examiner has failed to make a *prima facie* case of obviousness in the rejection. In making a 35 U.S.C. § 103(a) rejection, the Examiner is required to present a *prima facie* case of obviousness in accordance with the rules outlined by the U.S. Supreme Court in both *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) and *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). In making a *prima facie* case of obviousness, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is expected to make a factual determination employing the criterion set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art, and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the Examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In

re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR* at 1741, 82 USPQ2d at 1396 (2007)). Further, a rejection based on 35 U.S.C. § 103 must rest upon a factual basis rather than conjecture or speculation. "Where the legal conclusion [of obviousness] is not supported by the facts, it cannot stand." *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). See also *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) and *Kahn*, 441 F.3d at 988.

Buchanan's failure to disclose, teach or suggest a "real time" or "concurrent" system has been established. Thus, Buchanan does not satisfy the first *Graham* factor related to scope and content. Applicants will show below that Kern also fails to disclose, teach or suggest a "real time" or "concurrent" system as claimed and, thus also fail to satisfy the first *Graham* factor.

Regarding the scope and content of Kern, Applicants respectfully assert that Kern teaches the real time storage of a scanned image on a single computer and magnetic/optical disk system and fails to disclose, teach or suggest the claimed "real time" or "concurrent" sharing of a digital image with a second financial institution or image exchange server. (Kern, col. 10, lines 3-10). Kern's invention is further described in detail below, but the scope and content of Kern is limited to a single computer with a scanner and storage device, where the scanned image is copied to the storage device. (Kern, col. 10, lines 6-14). A careful reading of Kern shows that Kern's single computer and storage system is not designed to support a "real time" or "concurrent" sharing of a digital image with a second financial institution or image exchange server. Comparatively, Applicants claim a "real time" or "concurrent" system which is defined as the "concurrent or simultaneous exchange of electronic or digital information between two or more computers/servers." (Applicants, claims 1, 2, 3, 7, 18, 22 and 24; amended para. 6). The foregoing arguments clearly show that Kern fails to satisfy the first *Graham* factor. Therefore,

the combination of Buchanan and Kern also fails to satisfy the first *Graham* factor related to scope and content.

Regarding the second *Graham* factor related to the difference between art and claims, the combination of Buchanan and Kern do not overcome the limitations raised in the foregoing arguments regarding the first *Graham* factor related to scope and content. Those arguments are not repeated again for brevity. Thus, for the reasons stated above, the second *Graham* factor is not satisfied, since Buchanan in combination with Kern is different from Applicants' claimed invention.

Evaluating Kern's invention in detail, as related to the Examiner cited material, shows that Kern has a single computer system, with real time (concurrent) transmission relating to the document processor 32. Kern's document processor 32 provides for "capturing, processing, and compressing images in real time" and transferring those same images to the storage and retrieval unit 40 across the optical network 41. (Kern, col. 10, lines 3-14). Kern further describes the optical network 14 as being capable of residing at a remote location. (Kern, col. 10, lines 60-63). Applicants' review of Kern shows that Kern's storage and retrieval unit 40 is not another computer or server. (Kern, col. 10, lines 48-59). Instead, Kern discloses that the storage and retrieval unit 40 is a high capacity disk-based magnetic storage and retrieval unit. (Kern, col. 6, lines 1-3). Thus, Kern does not disclose, teach or suggest a "real time" or "concurrent" process as claimed by Applicants.

Additionally, Kern's express discussion about sequential activity teaches away from Applicants' claimed invention. (Kern, col. 10, lines 10-12). Specifically, Kern states the "images are available for sending to the workstations 50 a very short time after they have been captured by the document processor 32." (Kern, col. 10, lines 10-12). Thus, Kern clearly

teaches away from using a "real time" or "concurrent" system, as defined and claimed by Applicants.

The combination of Kern with Buchanan fails to teach or suggest Applicants' claimed invention. Kern and Buchanan both fail to teach or suggest "real time" or "concurrent" sharing of a digital image with a second financial institution or image exchange server. Kern's optical network 41 may be remote, but as discussed above, it expressly teaches a single storage location for later retrieval. Therefore, it is clear that the facts do not support an obviousness rejection of independent claims 1, 2, 3, 7, 18, 22 and 24 over Buchanan, in combination with Kern, since both fail to disclose a "real time" or "concurrent" process as claimed. Additionally, Applicants respectfully submit that at least two of the three *Graham* factors are not satisfied by the combination of Buchanan and Kern.

Finally, the Examiner states that "it would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Buchanan and Kern to achieve a higher efficiency during processing [of] document[s], image[s], or etc." (emphasis added). Applicants do not claim "a higher efficiency during processing [of] document[s], image[s], or etc." Instead, Applicants claim a "real time" or "concurrent" communication of an image. Applicants do not disclose or claim any efficiency elements within the claimed invention.

Thus, in view of the foregoing arguments, the Applicants respectfully submit that independent claims 1, 2, 3, 7, 18, 22 and 24 are in a condition for allowance, as well as the claims that depend therefrom. Therefore, the Applicants respectfully request the reconsideration and withdrawal of the rejection of pending claims 1-7, 18-22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Buchanan in view of Sharp.

Buchanan In View of Green and Kern

Applicants respectfully traverse the Examiner's rejection of claims 11-17 and 23 as being unpatentable over Buchanan in view of Green and Kern. The arguments above regarding Kern are incorporated herein. In the Office Action, the Examiner cites Green as having an image exchange server and Kern as providing a "real time" or "concurrent" capability. Applicants discuss above the failings of Buchanan and Kern to teach or suggest a "real time" or "concurrent" process or system. A careful review of Green also fails to produce any teaching or suggestion of a "real time" or "concurrent" transmission, communication or exchange of digital image and/or digital data record with a second site. Applicants respectfully re-assert that Buchanan in view of Green and Kern fails to disclose, teach or suggest an image exchange server having a "real time" or "concurrent" process or system as claimed and previously addressed in prior Office Actions responses. Thus, Applicants respectfully assert that the *prima facie* case of obviousness has not been met.

Thus, in view of the foregoing arguments and the failure of both Green and Kern to provide for a "real time" or "concurrent" process as defined by Applicants, Applicants respectfully submit that independent claims 11, 13, 16, and 23, and the claims that depend therefrom, are in a condition for allowance. Therefore, Applicants respectfully request the reconsideration and withdrawal of the rejection of pending claims 11-17 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Buchanan in view of Green and Kern.

Buchanan and Kern In View of Green

Applicants respectfully traverse the Examiner's rejection of claims 8-10 as being unpatentable over Buchanan and Kern, as applied to the rejection of claim 7 above, in view of Green. The Applicants respectfully submit that claims 8-10 are in an allowable condition since

they depend from an allowable claim. The Applicants respectfully request reconsideration and withdrawal of the rejection of pending claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Buchanan and Kern in view of Green.

In view of these arguments, Applicants believe claims 1-24 are in a condition for allowance. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of pending claims 1-24 under 35 U.S.C. § 103(a).

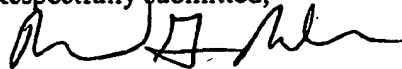
Conclusion

In view of the foregoing arguments, Applicants submit that the Examiner's rejection of claims 1-24 should be withdrawn, and respectfully request the allowance of claims 1-24.

This is intended to be a complete response to the Office Action mailed on March 31, 2008.

June 30, 2008
Date

Respectfully submitted,



Richard G. Miller
Registration No. 59,447
McAFEE & TAFT
Tenth Floor, Two Leadership Square
211 North Robinson
Oklahoma City, Oklahoma 73102-7103
Tel.: (405) 552-2249
Fax: (405) 228-7449
Attorney for Applicants

E-mail: richard.miller@mcafeetaft.com